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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,596	11/24/2003	Jonah Harley	10030476-1	8687

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL 429
Intellectual Property Administration
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EXAMINER

WU, XIAO MIN

ART UNIT PAPER NUMBER

2629

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,596

Applicant(s)

HARLEY ET AL.

Examiner

XIAO M. WU

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/9/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 2, the recitation of "said puck" has no antecedent basis. Also the limitation of "A second arcuate spring" is indefinite since there is no first arcuate spring cited previously. Claim 2 is in independent claim format. However, it looks like claim 2 should be depending from claim 1.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobachi et al. (US Patent No. 6,326,948).

As to claim 1, Kobachi discloses an apparatus comprising: a moveable puck (1, Fig. 1); a boundary defining a puck field of motion in which said puck moves relative to said boundary (see Fig. 1); and a first arcuate spring (2, Fig. 1; also see 2, Fig. 27) having a first end connected to said puck and a second end connected to said boundary (see Figs. 1 and 27), said arcuate

spring applying a force to said puck that maintains said puck in a predetermined region of said puck field of motion when no external force is applied to said puck (see col. 2, lines 34-37).

As to claim 2, Kobachi discloses a second arcuate spring having a first end connected to said puck and a second end connected to said boundary, said arcuate spring applying a force to said puck that maintains said puck in a predetermined region of said puck field of motion when no external force is applied to said puck (see Figs. 1 and 27; also see col. 2, lines 34-37).

As to claim 3, Kobachi discloses the first arcuate spring comprises a planar spiral member (see 2, Fig. 27).

As to claim 4, it is inherent that first arcuate spring also applies a force that dampens any oscillations in said puck position when said puck returns to said predetermined region in said puck field of motion. Because the spring can expand and shrink.

As to claim 6, Kobachi discloses the boundary comprises an opening in a layer of material (see Fig. 1).

As to claim 7, Kobachi discloses the material comprises plastic (see col. 2, lines 34-46).

As to claim 8, Kobachi discloses the material comprises metal (col. 2, lines 47-48).

As to claim 9, Kobachi discloses the puck and the springs comprise a portion of said layer of material (see Fig. 27).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobachi et al. (US Patent No. 6,326,948) in view of Devolpi (US Patent No. 6,256,012).

As to claim 5, it is noted that Kobachi further discloses that the puck (1, Fig. 32A) is connected to an electrode (see Fig. 32A). However Kobachi does not specifically disclose one of said arcuate springs electrically connects said electrode to a point outside said puck field of motion. Devolpi is cited to teach a movable puck similar to Kobachi. Devolpi further teaches a spring connecting to an electrode (see 38, Fig. 12; also see col. 4, lines 16-24). It would have been obvious to one of ordinary skill in the art to have modified Kobachi with the features of the spring connected to electrode as taught by Devolpi so as to provide an electrical signal related to the position of the spring.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The US Patents 4,670,743, 5,056,146, 5,086,296, 5,504,502, 5,704,037, 5,808,603, 5,956,016 are cited to teach a cursor control device.

Art Unit: 2629


Any inquiry concerning this communication or earlier communications from the examiner should be directed to XIAO M. WU whose telephone number is 571-272-7761. The examiner can normally be reached on 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD HJERPE, can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

x.w.

May 23, 2006


XIAO M. WU
Primary Examiner
Art Unit 2629